IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

DAVID W. SMITH

Serial No.: 09/225,388	Group Art Unit: 2616
Filed: JANUARY 05, 1999	Examiner: Toan D. Nguyen
	Conf. No.: 2528
	Atty. Dkt.: 2000.002500/TT2581

For: METHOD AND APPARATUS FOR
PATTERN MATCHING ON SINGLE
AND MULTIPLE PATTERN
STRUCTURES

CUSTOMER NO.: 23720

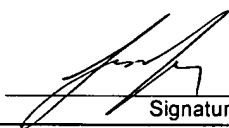## REMARKS CONCERNING PRE-APPEAL BRIEF--REQUEST FOR REVIEW

MAIL STOP AF
Commissioner for Patents
P. O. Box 1450
Alexandria, VA 22313-1450

Sir:

Applicant submits the following remarks concerning the Pre-Appeal Brief Request for Review and Notice of Appeal filed concurrently herewith. A Notice of Appeal and the corresponding fee is being filed concurrently herewith.

In the present Office Action, the Examiner rejected claims 1-2, 9, 23-24, 31-32 and 34 under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 5,802,305 *(McKaughan)* in view of U.S. Patent No 5,748,688 *(Kim)*. For example, as elaborated further below, *Kim* does not disclose detecting the size of the data for decoding purposes. In fact, *Kim* is explicit in indicating that the detection of the size of the data is made only to perform a bit pattern detection process. Therefore, *Kim* does not disclose an enabling disclosure that would anticipate the detection of the size of a bit stream as called for by claims of the present invention. Further, *Kim* differentiates the data pattern detection process with a separate decoding function. In other words, the fact that *Kim* discloses detecting the size of the data to perform a first function, *i.e.*, a bit pattern detection process, as well as the fact that *Kim* differentiates explicitly between the first function and a second function, *i.e.*, decoding process, clearly indicates that the detection of

the size of the data performed by *Kim* is not directed to performing for the second function. In other words, *Kim* simply does not disclose detecting the size of the data to perform a detection process, as called for by claims of the present invention. Further, as described in detail below, *McKaughan* does not disclose detecting the size of the data.

Moreover, the Examiner, in the Final Office Action, did not address various arguments provided by the Applicant with regard to the lack of disclosure of *Kim* and *McKaughan*. *McKaughan*, which is the primary reference, does not disclose or make obvious several elements of claim 1 of the present invention, and *Kim* does not make up for the deficit of *McKaughan*. *McKaughan* refers to a computer network that contains a plurality of interconnected computers, wherein a network interface card of sleeping computers detects an incoming packet and compares the incoming packet to a list of packets stored on the network interface cards. *McKaughan* then compares the received packet to a list of packets on the card and provides a wake-up sequence of a remote computer (see column 6, lines 43-64 of *McKaughan*). However, *McKaughan* does not disclose detecting the size of the received set of data signals as called for by claim 1 of the present invention. *McKaughan* merely discloses detecting an incoming packet over a network and filtering the incoming packet with a comparison mask. This does not make obvious the element of detecting the size of the received set of signals or other elements of claim 1. *McKaughan* does not disclose detecting the size of the received set of signals. Therefore, Applicant respectfully asserts that among other elements, *McKaughan* simply does not disclose or make obvious the element of detecting the size of the received set of signals when determining whether to wake up the computer.

McKaughan simply does not disclose detecting the size of the received set of data signals in the context of determining whether the received data signal should be received by the host circuit and waking up the whole circuitry as called for by claims of the present invention.

McKaughan merely refers to filtering the incoming packet, comparing the resulting filtered incoming packet to the corresponding packet in a list stored on a network interface card and making a decision whether to wake up the computer. *See* Fig. 4 and col. 8: 45-47, col. 9: 3-13 of *McKaughan*. *McKaughan* does not disclose detecting the size of the received set of signals when determining whether to wake up the computer, which is an element called for by claim 1. Further, *Kim* does not make up for the deficits of *McKaughan*. In the Office Action dated November 28, 2007, the Examiner admits that *McKaughan* does not disclose detecting a size of the received set of data signals to use as a factor for decoding the data. Applicant respectfully asserts that the Examiner is correct in the statement but, further, *McKaughan* does not disclose or make obvious other elements of claim 1 of the present invention. Regarding detecting the size of the data received, *Kim* does not make up for this deficit. The Examiner simply point to the Abstract of *Kim* to argue obviousness of the element of detecting a size of the received set of data signals to use as a factor for decoding the data. However, neither this portion of any other portion of discloses detecting a size of the data to use as factor for decoding the data.

Kim discloses that the detection of the size of the data is made to perform a bit pattern detection process, and not for decoding purposes. *See* Abstract, col. 2, line 55-col. 3, line 8; Fig. 2. The size of the data is detected to determine the position of the bit pattern to be matched. *Id.* However, *Kim* does not disclose detecting the size of the data for any type of decoding purpose. In fact, *Kim* discloses that the pattern matching function, in which size of the data is detected, is a separate function from performing a decoding function. *Kim* explicitly discloses that after the input data stream is converted from serial to parallel format, it is sent to two different functions: a pattern matching function (in which the size of the data is detected)—"bit pattern detector" 200, and a decoding function—"Code Table" 330. *See* Fig. 3; col. 5: 53-col. 6: 4. Therefore, *Kim* explicitly discloses that detection of the size of the data is not used as any type of a factor

for decoding the data, but is simply used to performing pattern matching. Further, *Kim* explicitly makes clear that the pattern matching function is different from the decoding function. Therefore, *Kim* fails to make obvious at least the element of detecting a size of the received set of data signals to use as a factor for decoding the data. In fact, *Kim* affirmatively indicates that the size of the data is <u>not</u> used for any type of decoding purposes. As noted above, the Examiner had indicated that this element is not disclosed or made obvious by *McKaughan*. Accordingly, the combination of *Kim* and *McKaughan* does not make obvious all of the element of claim 1 of the present invention. Further independent claims 23, 32, and 34 also call for various method and apparatus limitations similar to the subject matter described above. The arguments relating to claim 1 also apply to claims 23, 32, and 34. Therefore, all of the elements of independent claim 1, 23, 32, and 34 are not made obvious by *Kim, McKaughan*, or their combination and thus, claims 1, 23, 32, and 34 and their respective dependent claims are allowable for at least the reasons cited herein.

Further, without using improper hindsight reasoning, those skilled in the art would not combine *Kim* and *McKaughan* in such a manner as claimed by the present application. Further, *McKaughan* and *Kim* are incompatible; *McKaughan* refers to a computer network that contains a plurality of interconnected computers, wherein a network interface card of sleeping computers detects an incoming packet and compares the incoming packet to a list of packets stored on the network interface cards. In contrast *Kim* is directed to performing a pattern matching function. *Kim* does not even mention the terms sleep or sleep mode. Accordingly, the Examiner failed to establish a *prima facie* case of obviousness has not been established in rejecting claims 1-2, 9, 23-24, 31-32 34 and 35.

Regarding the rejection of claims 3-6, 8, 10-18, 20-22, 25-28, 30, 33 and 35 under 35 U.S.C. 103(a) as being unpatentable over *McKaughan*, in view of Kim and further in view of

U.S. patent No. 4,516,201 (*Warren*), the rejection is erroneuous. The deficit of *McKaughan* and *Kim* are not made up for by *Warren*. For example, *Warren* discloses a host 12 that passes data transmitted by a data link 14, which is examined by a controller 10. *See* col. 6, lines 25-36. However, the system disclosed by *Warren* does not check for the size of the data signals; it merely converts the received signal from parallel to a serial format. *See* col. 6: 25-36. *Warren* merely discloses a link 14 that presents the serial string as parallel words to the host 12. *See* col. 6, lines 37-48. *Warren* discloses status information regarding the data link 14 being provided to the host 12 to take action, however *Warren* does not disclose any status information regarding the size of the received data signal as called for by the claims. The only reference to memory size in *Warren* relates to the limitation of the host system. *Warren* discloses that the host system may be joined via the controller where memory size, data handling capacity, or speed limitations would otherwise preclude their joining to a data link 14. *See* col. 7, lines 7-17. However, this does not relate to receiving data signals and detecting the size of the received signals and performing the coding and various other steps for waking up a host circuitry. *Warren* is generally directed towards the data communication link such as a modem providing a queue for data in a controller. This is vastly different from the disclosure of *McKaughan*, which is directed towards a wake-up sequence. Therefore, without impermissible hindsight, one of ordinary skill in the art would not combine the disclosure of *McKaughan* and *Warren* to make obvious any of the claims 3-6, 8, 10-18, 20-22, 25-28, 30, 33, and 35 of the present invention. Thus, the Examiner erred in maintaining the rejections.
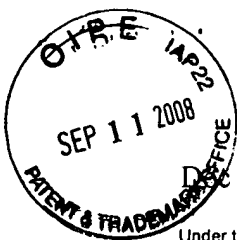
Respectfully submitted,
WILLIAMS, MORGAN & AMERSON, P.C.

Date: September 8, 2008   By: _____

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Doc Code: AP.PRE.REQ

PRE-APPEAL BRIEF REQUEST FOR REVIEW	Docket Number (Optional) 2000.002500/TT2581	
I hereby certify that this correspondence is being deposited with the United States Postal Service **via facsimile** addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)] on **September 8, 2008** Signature_____ Typed or printed name **Jaison C. John**	Application Number **09/225,388**	Filed **January 5, 1999**
	First Named Inventor **David W. Smith**	
	Art Unit **2616**	Examiner **Toan D. Nguyen**

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
        Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☑ attorney or agent of record. **50,737**
Registration number

☐ attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____

_____
Signature

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Typed or printed name

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Telephone number

September 8, 2008
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☑ *Total of ____1____ forms are submitted.